



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-----------------------------|-------------------------|------------------|
| 10/713,863 | 11/14/2003 | Magdalena Wolska | 128534-00501 (07027356) | 1865 |
| 26565 7590 09/30/2008 MAYER BROWN LLP P.O. BOX 2828 CHICAGO, IL 60690 | | | | |
| EXAMINER DESAL RACHINA SINGH | | | | |
| ART UNIT 2176 | | PAPER NUMBER | | |
| NOTIFICATION DATE 09/30/2008 | | DELIVERY MODE ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@mayerbrown.com

**Advisory Action
Before the Filing of an Appeal Brief**

| | |
|--------------------------------------|--------------------------------------|
| Application No. 10/713,863 | Applicant(s) WOLSKA ET AL. |
| Examiner RACHNA S. DESAI | Art Unit 2176 |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 September 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-18 and 20-30.
Claim(s) withdrawn from consideration: 31-54.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Rachna S Desai/
Primary Examiner, Art Unit 2176

Continuation of 3. NOTE: Applicant's amendment incorporates limitations previously presented in a dependent claim 5 (i.e. wherein function words of the essay are excluded when calculating the feature values) which are not deemed to simplify issues for appeal. As stated in the final office action, while Foltz does not teach function words are not considered in determining feature values, Mitchell teaches extracting words to simplify word recognition and analysis by reducing the number of variations in words. Thus certain words are not considered by the assessment tool. See pages 1-3, paragraphs [0041]-[0067].

Continuation of 11, does NOT place the application in condition for allowance because: Applicant argues Mitchell does not teach certain words of the essay are not considered by the assessment tool since they are converted to the reduced variant form specifically so they can be considered. Examiner disagrees. Mitchell teaches extracting propositions, adjectives, etc from the mark scheme answers (i.e. removing function words) to reduce variant forms of these words to their root form. The intent is to help simplify the word recognition and sentence analysis process by reducing the number of variations of the words. Thus certain words of the essay are not considered by the assessment tool since they are altered to the reduce variant form. See pages 1-3, paragraphs [0041]-[0067]. It would have been obvious to a person of ordinary skill in the art at the time of the invention to not consider certain words when determining feature values to simplify the word recognition and sentence analysis process by reducing the number of variations of the words. See pages 1-3, paragraphs [0041]-[0067]. Applicant argues that the words are converted to variant form so they can be considered; however, they are converted to variant form so the "function words" are not themselves considered.

Applicant argues dependent claims 11 and 25 are not taught by Mitchell because Mitchell does not process pronouns at all. Examiner disagrees. Mitchell teaches parsing a free-form text answer into constituent parts including nouns, verbs, adjectives, and proper names. See page 1, paragraphs [0003] and [0015]. The nouns are pattern matched in the student answer against nouns in the mark scheme. See figure 7. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Mitchell's indication of whether a noun is present as a feature of an essay in the system of Foltz in order to take into account potential variations in writing styles by matching potential variations of the pronoun to a word in the student answer/essay.

In view of the comments above, the rejection is maintained.